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EXAMINER

STORK, KYLE R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

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Technology Center 2100

Application Number: 09/998,396
Filing Date: November 15, 2001
Appellant(s): KEOHANE ET AL.

Volel Emile
Reg. No. 39,969
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5 January 2007 appealing from the Office
action mailed 4 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-20 appears on pages 5-9 of the Appendix to the appellant's brief. The minor errors are as follows: The applicant has used the status identifiers of the amendment submitted 8 February 2005 instead of updating the status identifiers.

(8) Evidence Relied Upon

"Adobe GoLive(tm) 5.0 User Guide," Adobe Systems Incorporated, 2000, pp. 109-110.

Microsoft(r) Word(r) Screenshots, Figures 1-7.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 4, 7, 10, 13, 15, 17, and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Adobe GoLive™ 5.0 User Guide (2000, hereafter Adobe).

As per independent claim 1, Adobe discloses the method of displaying a document having at least one section that is to be highlighted based on an intended user comprising the steps of:

- Displaying the document (pages 109-110: Here, viewing options for the display of a document can be set)
- Displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the intended user (page 109-110, steps 11-12: Here, a user can assert a button to highlight all items tagged with a specific class, ID, or tags. As the applicant discloses in paragraphs 0037-0038 of the specification, the highlighting occurs between specific HTML tags. Adobe similarly will highlight sections of a displayed document between specified tags or having a specified ID)
- Highlighting the at least one section of the document when the at least one button is asserted (page 109-110, steps 11-12)

As per independent claim 4, the applicant discloses the limitations similar to those in claim 1. claim 4 is similarly rejected under Adobe.

As per independent claim 7, the applicant discloses the limitations similar to those in claim 1. claim 7 is similarly rejected under Adobe.

As per independent claim 10, the applicant discloses the limitations similar to those in claim 1. claim 10 is similarly rejected under Adobe.

As per dependent claim 13, Adobe discloses the method wherein the at least one section to be highlighted is within a pair of tags (page 109-110, steps 11-12).

As per dependent claim 15, the applicant discloses the limitations similar to those in claim 13. claim 15 is similarly rejected under Adobe.

As per dependent claim 17, the applicant discloses the limitations similar to those in claim 13. claim 17 is similarly rejected under Adobe.

As per dependent claim 19, the applicant discloses the limitations similar to those in claim 13. claim 19 is similarly rejected under Adobe.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 5-6, 8-9, 11-12, 14, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adobe in further in view of Microsoft® Word® (citations for claims 2-3, 5-6, 8-9, and 11-12 refer to screenshots provided with the office action of 22 September 2004; citations for claims 14, 16, 18, and 20 refer to new screenshots provided with this office action; hereafter Word).

As per dependent claim 2, Adobe discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Adobe fails to specifically disclose the method wherein highlighting the section entails graying out the document except the section. Word discloses the method of graying out the document in sections

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not currently selected (Figure 5: Here, the header/footer of the document is selected and the body of the text is grayed out accordingly).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Adobe's method with Word's method, since it would have allowed a user to see a greater contrast between the selected text which is highlighted and the unselected text which is grayed out.

As per dependent claim 3, Adobe discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Adobe fails to specifically disclose the method wherein highlighting the section entails displaying the section in a different color. Word discloses the method wherein highlighting the section entails displaying the section in a different color (Figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Adobe's method with Word's method, since it would have allowed a user to see a greater contrast between highlighted text and normal text.

As per dependent claim 5, the applicant discloses the limitations similar to those in claim 2. claim 5 is similarly rejected under Adobe.

As per dependent claim 6, the applicant discloses the limitations similar to those in claim 3. claim 6 is similarly rejected under Adobe.

As per dependent claim 8, the applicant discloses the limitations similar to those in claim 2. claim 8 is similarly rejected under Adobe.

As per dependent claim 9, the applicant discloses the limitations similar to those in claim 3. claim 9 is similarly rejected under Adobe.

As per dependent claim 11, the applicant discloses the limitations similar to those in claim 2. claim 11 is similarly rejected under Adobe.

As per dependent claim 12, the applicant discloses the limitations similar to those in claim 3. claim 12 is similarly rejected under Adobe.

As per dependent claim 14, Adobe discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Adobe fails to specifically disclose the method wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the tags for which the search engine is to search. Word discloses the method wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the information for which the search engine is to search (Figure 7: Here, a word is entered into the "Find" search box. The search engine then searches the document to find the next data item matching the search string).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Adobe's method with Word's method, since it would have allowed a user to easily highlight section based upon a user specified search.

As per dependent claim 16, the applicant discloses the limitations similar to those in claim 14. claim 16 is similarly rejected under Adobe.

As per dependent claim 18, the applicant discloses the limitations similar to those in claim 14. claim 18 is similarly rejected under Adobe.

As per dependent claim 20, the applicant discloses the limitations similar to those in claim 14. claim 20 is similarly rejected under Adobe.

(10) Response to Argument

The applicant's argument is based upon the applicant's belief that Adobe fails to, "teach, show or suggest a method of ***highlighting a section of a document by displaying a button with the document that indicates a user for which the section is to be highlighted and of highlighting the section when the button is asserted*** (page 5)". The examiner respectfully disagrees. Adobe discloses a highlighting button, which when depressed by a user highlights a section of a document (page 110, items 11-12). In this case, the highlighted sections of the documents are elements on a page formatted with a specific class, ID, or markup tag based upon the options that have been chosen from a Mark Element menu (page 110, items 11-13). Further, Adobe teaches a specific user for which the section is to be highlighted (page 109, section "Selecting viewing options"). Here, "you," a specific user, select viewing options for a web page through the "General User Interface preferences." By setting the "General User Interface preferences," every page opened by "you," the user, will have those preferences applied. Therefore, when "you" the selected user select to highlight data, based upon a "highlight button," the user preferences that have been previously set will take effect, and cause the data to be highlighted.

The appellant further argues the "applicants disclose that each button is labeled with an intended user, and when a button is asserted the label with an intended user is used by the invention as a search term in order to determine which part of the text is to be highlighted (page 6)." However, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellant further argues that Adobe fails to disclose using a button (page 6). The examiner respectfully disagrees. A menu item was notoriously well known in the art at the time of the applicant's invention to be a button. Therefore, depressing a button, which activates a drop down menu still includes depressing a button.


Finally, with respect to claims 2, 5, 8, and 11, the appellant seems to be arguing the limitations similar to those above. These arguments are similarly not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Kyle Stork
Patent Examiner
Art Unit 2178
4 November 2005

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